

Remarks

Objections to Claims 1, 2, 3, 4, 8, and 9

The Examiner objected to the following pairs of claims under 37 CFR § 1.75 (statutory double patenting rejection) as being substantial duplicates of each other:

Claim 1 is duplicated by Claim 2

Claim 3 is duplicated by Claim 8

Claim 4 is duplicated by Claim 9

Applicant has cancelled Claims 2, 8, and 9 thereby rendering the statutory double rejections to those claims moot. Applicant respectfully requests reconsideration and withdrawal of the objections to Claims 1, 2, 3, 4, 8, and 9 under 37 CFR § 1.75.

The § 103 (a) Rejections of Claims 1-4 and 8-22

The Examiner rejected Claims 1-4 and 8-22 under 35 U.S.C. § 103 (a) as obvious over Robinson, in view of Domanik and Olofson (all of record). Applicant has cancelled Claims 2, 8, and 9 thereby rendering the rejection of those claims moot. Applicant respectfully traverses the rejection of remaining Claims 1, 3, 4, and 10-22 and respectfully requests reconsideration.

To establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Moreover, it is improper to combine references which both teach away from the combination and where the combination would change the principal of operation of one or more of the cited references. (See MPEP § 2145).

Applicant courteously points to col. 2, lines 36-41 of Robinson in which the disclosed invention is described such that it “requires no opaque background coating on the reverse side of the slice for visual contrast.” Applicant further notes that the Olofson patent only discloses a slide in which one of the two information-bearing surfaces possesses two opaque coatings, one

on each side of the same end of the slide. (See Fig. 2 of Olofson showing two opaque coatings 14 and 16 on the same end and opposite sides of the slide.) Applicant respectfully submits that a person of ordinary skill in the art would not combine the Robinson patent with the Olofson patent to result in the claimed inventions because Robinson teaches that there is no need for an opaque coating on the reverse side of the slide.

In addition, Applicant points out that the invention disclosed in Olofson requires that one side of the information bearing coating must be etched or scribed away in a desired design to actually put the information into the coating material. Applicant respectfully submits that to place any readable or representative information onto the claimed microscope slide, which has a coating on only one side of the slide, it is necessary to alter the principle of operation of the slide disclosed in Olofson. Using Olofson, to put information on a slide, such as the representative "A" shown in Olofson, the coating applied to both sides of the slide is necessary.

Therefore, Applicant respectfully submits that the combination of Robinson, Domanik, and Olofson fails under § 103 (a) to render obvious independent Claims 1, 15, and 19 for two reasons. First, the Robinson patent teaches away from the two sided coating material disclosed in Olofson. Second, the principle of operation of the Olofson coating would have to be changed to conform to the inventions claimed in Claims 1, 15, and 19 of the instant application. Applicant respectfully requests reconsideration and passage to allowance of independent Claims 1, 15, and 19.

"If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Claims 3, 4 and 10-14 depend from Claim 1, Claims 16-18 depend from Claim 15, and Claims 20-22 depend from Claim 19 and thus incorporate all the limitations of those respective claims. Because, as discussed above, the combined Robinson, Domanik, and Olofson patents fail to render obvious independent Claims 1, 15, and 19, they also fail to render obvious Claims 3, 4, 10-14, 16-18, and 20-22, respectively. Applicant respectfully requests the removal of the rejections of Claims 2-4, 10-14, 16-18, and 20-22 and passage to allowance of those claims.

Claims 10-13 are rejected under 35 U.S.C. § 103 (a) as obvious over Robinson in view of Domanik and Olofson and further in view of Speelman (of record). Applicant respectfully traverses the rejection of these claims and requests reconsideration. \

Applicant courteously notes that Claims 10-13 depend from Claim 1 and therefore incorporate all the elements of Claim 1. As noted by the Examiner, Speelman discloses slides with beveled edges. However, Applicant courteously points out that Speelman must be combined with Robinson, Domanik, and Olofson to render Claims 10-13 obvious. As discussed above, Olofson fails as a reference under § 103 (a) both because Robinson teaches away from the use of the opaque over/under coating disclosed in Olofson and because to use Olofson in combination with Robinson, Domanik, and Speelman, would alter the principle of operation of Olofson. For these reasons, the combination of Robinson, Domanik, Olofson and Speelman fails to render Claims 10-13 obvious under § 103 (a). Applicant respectfully requests reconsideration and passage to allowance of those claims.

The Examiner rejected Claims 1 and 19-22 under 35 U.S.C. § 103 (a) as obvious over Robinson, in view of Domanik, Olofson and further in view of Rosenlof (of record). Applicant respectfully traverses the rejection of those claims and requests reconsideration.

Independent Claims 1 and 19 both claim a microscope slide with a non-transparent area on each side and opposite ends of the slide. Claim 19 includes a printed representation of the specimen carried by the slide. The Rosenlof patent is cited as disclosing a slide with a printed label or sticker. However, as discussed above, the combination of the Robinson, Domanik and Olofson references fails under § 103 (a) to render Claim 1 obvious as Robinson teaches away from the use of a coating on the same end and opposite sides of a slide as disclosed by Olofson. In other words, Robinson teaches away from the use of Olofson. Also as mentioned above, the use of Olofson in the instant claims changes the principle of operation of the Olofson disclosure thus making the Olofson patent unavailable as one of the combined 103 (a) references cited against Claims 1 and 19.

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Claims 20-22 depend from Claim 19 and thus incorporate all the limitations of that claim. Because, as discussed above, the combined Robinson, Domanik, and Olofson patents fail to render obvious independent Claim 19, they also fail to render obvious Claims 20-22. Applicant respectfully requests the removal of the rejections of Claims 20-22 and passage to allowance of those claims.

Conclusion

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully yours,



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